

REMARKS

In light of the above-amendments and remarks to follow, reconsideration and allowance of this application are requested.

Claims 1-11 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,266,403 (Ananikian et al.) in view of U.S. Patent No. 6,373,934 (Jensen). In order to expedite the prosecution of this application, applicants have amended the independent claims to recite that "calls start on a telephone and terminate on another telephone on the telephone line."

Ananikian et al. describes an indication device to display a data as a function of the detection of an off-hook situation (see col. 4, lines 19-30) even when call has been answered on another telephone on the telephone line. However, contrary to the Examiner's assertion, Ananikian et al. is not even remotely concern with the problem of the invention, namely providing reliable call duration data when a call is answered on a telephone and continued on another one. Applicant respectfully submit that Ananikian et al. is at best concerned with detecting an off-hook condition and is not at al concerned with reliably determining the duration of the call.

Jensen discloses a monitoring device for providing call detail records at the subscriber premises where multiple telephone numbers are used on a single line. (See col. 1, lines 12-67). "All outgoing long distance phone calls are billed to the primary number. Thus, the telephone bill provides no means of distinguishing between business and personal long distance calls." (Col. 1, lines 45-48).

It is appreciated that Jensen is dealing with the problem of distinguishing between business and personal calls where a single telephone line has multiple telephone numbers. Whereas the present invention is dealing with the problem of providing reliable call duration data when calls start on one telephone but terminates on another telephone on the telephone line. Jensen fails to teach or suggest "providing reliable call duration data even when calls start on a telephone and terminate on another telephone on the telephone line," as required in claims 1, 10 and 11. Accordingly, even assuming *arguendo* that

Ananikian et al can be combined with Jensen, the addition of Jensen does not cure the aforementioned deficiencies of Ananikian et al.

It is respectfully submitted that when one combines Ananikian et al. with Jensen, the results of such a combination still does not meet the terms of claims 1, 10 and 11 because neither reference teaches or suggests "providing reliable call duration data even when calls start on a telephone and terminate on another telephone on the telephone line."

In view of the foregoing differences, it is respectfully submitted that the combination of Ananikian et al. and Jensen does not render obvious claims 1, 10 and 11.

Further, there is no motivation in Ananikian et al. or in Jensen to suggest that the teachings of these two references should be combined. In re Sernaker, 217 U.S.P.Q. 1, 6 (Fed. Cir. 1983); SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8 U.S.P.Q. 2d 1468, 1475 (Fed. Cir. 1988); In re Fritch, (Fed. Cir. 1992) 91-1318; In re Laskowski, 10 U.S.P.Q. 2d 1397, 1299 (Fed. Cir. 1989); In re Fine, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).

The decision of In re Geiger, 2 U.S.P.Q. 2d 1276 (1987) is quite relevant. There, the Federal Circuit stated:

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination."

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"At best in view of these [prior art] disclosures, one skilled in the art might find it obvious to try various combinations of these known [agents]. However, this is not the standard of 35 U.S.C. Section 103."

Moreover, absent applicants' disclosure, there appears to be absolutely no reason to add Jensen to Ananikian et al. so as to provide reliable call duration data even when calls start on a telephone and terminate on another telephone, especially since these two references are concerned with completely different problems. In fact, the only reason one might turn to Jensen, if at all, is because of the hindsight gleaned from applicant's own

disclosure. The Federal Circuit has been consistent in warning against hindsight reconstruction of the prior art. As pointed out in Uniroyal v. Redkin-Wiley, 5 U.S.P.Q. 2d, 1434, 1438 (Fed. Cir. 1988):

“When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. ...Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.”

* * *

“...it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention.”

In Uniroyal, the CAFC referred to Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Company, 221 U.S.P.Q. at 489, to conclude that “the mere fact that a device or process utilizes a known scientific principal does not alone make that device or process obvious.” 5 U.S.P.Q. 2d at 1440.

In Orthopedic Equipment Company, Inc. v. United States, 217 U.S.P.Q. 193-199 (Fed. Cir. 1983), the Federal Circuit warned,

“The difficulty which attaches to all honest attempts to answer this question [of obviousness based upon a combination of prior art] can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law.”

In reversing an Examiner's rejection based upon obviousness, wherein the Examiner concluded that a claimed apparatus is shown simply by turning a prior art reference “upside down,” the CAFC ruled:

“The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.”

In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984), and citations noted therein.

In view of the foregoing, it is respectfully submitted that one of ordinary skill in the art, after reading and understanding Ananikian et al., would not even turn to Jensen – and if he did, he would not understand how or why Jensen’s monitoring device should be combined with Ananikian et al.’s telecommunication device.

Furthermore, the claimed invention defined by apparatus claims 1, 10 and 11 eliminates the shortcomings and disadvantages encountered with the prior art. Specifically, the claimed invention allows a telephone to provide reliable call duration data even when calls start on a telephone and terminate on another telephone. It is undeniable that neither Ananikian et al. nor Jensen is even remotely concerned with the problem associated with providing reliable call duration data even when calls start on a telephone and terminate on another telephone. Since applicant has recognized a problem not addressed by the cited prior art and solved that problem in a manner not suggested by either Ananikian et al. or Jensen, the basis for patentability of the claims is established. See In re Wright, 6 U.S.P.Q. 2d, 1959, 1961-1962 (Fed. Cir. 1988). There, the CAFC relied upon previous decisions requiring a consideration of the problem facing the inventor in reversing the Examiner’s rejection. “The problem solved by the invention is always relevant”. *Id.* at 1962. See also, In re Rinehart, 189 U.S.P.Q. 143, 149 (CCPA 1967), which stated that the particular problem facing the inventor must be considered in determining obviousness.

Absent evidence that the specific problem associated with providing reliable call duration data even when calls start on a telephone and terminate on another telephone was even recognized by the prior art, there can be no finding that the invention as a whole would have been obvious. As stated by the PTO Board of Appeals in Ex parte Breidt and Lefevre, 161 U.S.P.Q. 767, 768 (1968), “an inventive contribution can reside as well in the recognition of a problem as in a solution”. It further appears that the conclusion

reached by the Board of Appeals in Ex parte Minks, 169 U.S.P.Q. 120 (1969), is here in point. There, the Board concluded that “[a]ppellant having discovered the source of the problem and solved the same . . . he is . . . entitled to patent protection”. Id. at 121.

In view of the foregoing authorities, it is submitted that, since neither Ananikian et al. nor Jensen is even aware of the problem addressed by applicant, and since the cited prior art reference does not suggest the solution defined by claims 1, 10 and 11, these claims are unobvious and patentably distinct over the combination of Ananikian et al. and Jensen. The allowance of claims 1, 10 and 11 is solicited for the reasons given above.

Since claims 2-9 depend from claim 1, the foregoing discussion of claim 1 is equally applicable to claims 2-9 and the allowance of claims 2-9 is respectfully solicited for the reasons given above with respect to claims 1, 10 and 11.

Statements appearing above in respect to the disclosures in the cited references represent the present opinions of the applicant’s undersigned attorney and, in the event that the Examiner disagrees with any of such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the reference providing the basis for a contrary view.

Applicant’s representative agrees with the Examiner’s implicit finding that the prior art made of record and not relied upon is not as relevant to the claimed invention as Ananikian et al. and Jensen.

Accordingly, it is respectfully maintained that all rejections and objections have been overcome, and that the present application is now in condition for formal allowance.

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Applicant believes no fee is due. However, if a fee is due, please charge our Deposit Account No. 50-0624, under Order No. **NY-GRYN 204 (10109100)** from which the undersigned is authorized to draw.

Respectfully submitted,

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